

REMARKS

Upon entry of the present Response, claims 31, 36, and 40 will have been amended. Additionally, new dependent claims 45-46 will have been added for consideration by the Examiner. Claims 31-46 are pending.

Interview Summary

Applicant would like to thank the Examiner for conducting a telephone interview with representative for Applicant, John Mazzola, on September 1, 2010. During the interview, Mr. Mazzola argued the deficiencies of DUNN et al. (U.S. 5,916,302), with respect to the combination of features recited by the present claims. No specific agreement with respect to the claims was reached at this time.

Rejections and Response

In the outstanding Office Action, claims 31-37, 39-41, and 43-44 were rejected under 35 U.S.C. §103(a) as being unpatentable over DUNN et al. (U.S. 5,916,302) in view of BERKLEY et al. (U.S. 6,546,005). Claim 38 was rejected under 35 U.S.C. §103(a) as being unpatentable over DUNN et al. in view of BERKLEY et al. further in view of FUKUOKA et al. (U.S. 5,914,940). Claim 42 was rejected under 35 U.S.C. §103(a) as being unpatentable over DUNN et al. in view of BERKLEY et al. and further in view DeSIMONE et al. (U.S. 6,138,144).

Applicant does not acquiesce in the propriety of any of the outstanding rejections, but has amended independent claims 31, 36, and 40 solely in order to expedite prosecution and obtain early allowance of the claims. Additionally, Applicant has made an additional amendment to claim 36 for enhanced clarity. New dependent claims 45-46 will have been added for consideration by the Examiner. Dependent claims 45-46 add no prohibited new matter and recite a combination of features that are not taught by the documents cited in the Office Action.

Amended independent claim 31 recites, *inter alia*, determining a configuration of customer premise equipment for the calling party and customer premise equipment for the called party, the determining being initiated by a network node in response to the telephone call; and automatically establishing a separate, parallel virtual data channel to facilitate a data communication between the called party and the calling party over a packet data network in response to receiving the telephone call at the telephony network, when the configuration of customer premise equipment for the calling party is compatible with the configuration of customer premise equipment for the called party.

The Office Action correctly acknowledges that DUNN et al. fails to teach the data channel being automatically established in response to receiving a telephone call at the telephony network. In an attempt to compensate for the deficiencies of DUNN et al., the Office Action attempts to rely upon the holding of *In re Venner*, 262 F.2d 91, 95, 120, USPQ 193,194 (CCPA 1958). In this regard, the Office Action asserts that the court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art. Further, the Office Action asserts that it would have been obvious to establish the data channel automatically instead of manually.

However, the Office Action apparently has not considered the presently claimed limitation of automatically establishing a separate, parallel virtual data channel to facilitate a data communication between the called party and the calling party over a packet data network in response to receiving the telephone call at the telephony network, *when* the configuration of customer premise equipment for the calling party is compatible with the configuration of customer premise equipment for the called party. Thus, the separate, parallel virtual data channel is automatically established *when* the respective configurations are compatible. It is not

automatic that the respective configurations are compatible, and consequently, not a given that the separate, parallel virtual data channel will be established. Clearly, the claimed recitation is not merely blindly automating a mechanical activity. Thus, for at least these reasons, *In re Venner* is not on point. Accordingly, Applicant respectfully requests that the rejections in view of *In re Venner* be withdrawn.

The Office Action admits that DUNN et al. merely establishes a parallel connection upon the request of a user (i.e., a manual establishment). By failing to contemplate the relevancy and impact of the combination of features recited in Applicant's claim 31, and by thus failing to use these features as recited in Applicant's claim 31, DUNN et al. actually provides evidence of the non-obviousness of this combination of features.

Additionally, the Office Action correctly acknowledges that DUNN et al. fails to teach determining a configuration of customer premise equipment for the calling party and customer premise equipment for the called party and the establishing of a separate parallel virtual data channel if the configurations are compatible.

Instead, the Office Action attempts to rely on BERKLEY et al. to compensate for the deficiencies of DUNN et al. In support of its assertion, the Office Action relies in part upon col. 11, lines 18-54 and Fig. 3c of BERKLEY et al. However, BERKLEY et al. requires the subscriber to contact the AUR system which compares the subscriber request (URL address and e-mail message) against the user's preferences (e-mail, voice mail or fax). *See*, BERKLEY et al., col. 11, lines 18-54). Thus, the subscriber in BERKLEY et al. must contact the AUR system at which point user preferences are reviewed by the system.

In contrast, in the present application, determining a configuration of customer premise equipment for the calling party and customer premise equipment for the called party in the

present application is triggered by placing a call from a calling party to a called party (see, e.g., paragraph 0032 of the present application as filed), which is transparent to the calling party. Notably, the present application does not require additional efforts on the part of the calling party such as accessing websites, requesting URL addresses, leaving e-mails, etc. As recited in amended claim 31, the determining is "initiated by a network node in response to the telephone call". Clearly, for at least these reasons, BERKLEY et al. does not compensate for the deficiencies of DUNN et al.

Accordingly, neither DUNN et al. nor BERKLEY et al., either individually or in any proper combination, disclose or suggest the combination of features of the method recited in claim 31, nor the similar combination features of the methods recited in independent claims 36 and 40. Thus, Applicant respectfully requests that the rejections based on DUNN et al. in view of BERKLEY et al. be withdrawn.

Consequently, independent claims 31, 36, and 40 are in condition for allowance. With regard to dependent claims 32-35, 37-39, and 41-46, they are allowable on their own merit, in addition to being allowable for depending either directly or indirectly from independent claim 31, 36, or 40, which Applicants have shown to be allowable. Thus, at least in view of these arguments, claims 31-46 are in condition for allowance.

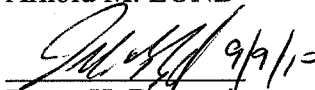
Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections of the claims, as well as an indication of the allowability of each of the claims in view of the above remarks.

SUMMARY AND CONCLUSION

The present application is in condition for allowance. Any amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
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